

Application No. 09/160,503
Amendment dated December 26, 2005
Reply to Office Action dated August 24, 2005

REMARKS

Claims 1, 5, 6, 21, 23, 25, 42, 43, 48, and 50 have been amended. Claims 13-20 and 33-40 have been withdrawn. Claims 1-12, 21-32, and 41-51 are currently pending in the application.

The Examiner rejected claims 1-4, 21-24, and 42-51 under 35 U.S.C. § 102(e) as being anticipated by Masuda et al. (USPN 5,978,041; hereinafter "Masuda"). The Examiner rejected claims 5-12, 25-32, and 41 under 35 U.S.C. § 103(a) as being unpatentable over Masuda. Applicant traverses these rejections and requests reconsideration of the application.

Official Notice

The Examiner used Official Notice to reject claims 5, 11, 12, 25, 31, and 32. The Manual of Patent Examining Procedure (MPEP) states in section 2144.03 that "[o]fficial notice unsupported by documentary evidence should only be taken by the Examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well known. ... *If such Notice is taken, the basis for such reasoning must be set forth explicitly. The Examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge.*"

Applicant respectfully submits the Examiner did not provide Applicant with specific factual findings predicated on sound technical and scientific reasoning to support his conclusion. Instead the Examiner simply stated the elements and limitations in dependent claims 5, 11, 12, 25, 31, and 32 are design choices that would have been obvious to one skilled in the art. This assumption by the Examiner does not provide Applicant with the specific factual findings needed to understand the

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Examiner's reasoning and therefore challenge the assertion of Official notice in this Amendment.

Applicant submits it would not have been obvious at the time of the invention to embed the special window information into the video signal using one of the color signals in the video signal, to include a shape sequence in the special window information when the shape of a target area is not rectangular, and to include a selection sequence in the special window information. It would also not have been obvious at the time of the invention to use one color signal in the video signal as a video clock signal for the special window information.

Applicant therefore demands the Examiner either withdraw the Official Notice or explicitly set forth the basis for such Notice and produce documentary evidence to support the Notice if the Examiner continues to take Official Notice in subsequent office actions.

Inherency

The Examiner stated the elements and limitations in claims 2, 7, 10, 22, 27, and 30 are inherent in Masuda's system. The MPEP states in section 2112 that the "fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (emphasis original). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' " *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted). "In relying upon the theory of inherency, the examiner must provide a basis in fact

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and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis original).’ ”

Applicant notes the Examiner did not provide *any* basis in fact or technical reasoning to support his determination that the allegedly inherent characteristic necessarily flows from the teachings of Masuda in his rejections of claims 2, 7, 10, 22, 27, and 30. The Examiner simply stated claims 2, 7, 10, 22, 27, and 30 “are inherent in Masuda’s system.”

Applicant submits Masuda does not suggest or provide a basis for inherency for claims 2, 7, 10, 22, 27, and 30. Nothing found in Masuda suggests a window manager being included in an operating system, coloring pixel pairs in a complementary manner to visually approximate a single pixel of a mixed color, and including a number sequence in the special window information. Unfortunately, Applicant is unable to respond to the assertion of inherency without a better understanding of why the Examiner believes these claims to be inherent in Masuda’s system.

Applicant therefore demands the Examiner either withdraw the assertion of inherency or provide a basis in fact or technical reasoning if the Examiner maintains this assertion in subsequent office actions.

102 Rejection

Applicant notes that in order for a reference to anticipate an invention, each and every element of the claimed invention must be found in a single reference. The “identical invention must be shown in as complete detail as is contained in the ... claim. The elements must be arranged as required by the claim...” MPEP Section

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2131.01. Applicant respectfully submits that Masuda does not anticipate Applicant's claims because Masuda does not disclose each and every element in Applicant's claims.

Applicant's independent claims 1, 21, 42, and 43, as amended, recite "special window information in a video signal comprised of a first color signal, a second color signal, and a third color signal *with said first color signal including said special window information*, wherein said video signal characterizes said image to be generated on said display *and said first and second color signals are used to display said special window information on said display*." Nothing found in Masuda teaches these aspects of the claimed invention. Masuda does not embed special window information in one color signal in the video signal. Nor does Masuda teach using the color signal that includes the special window information and another color signal to display the special window information on the display. Therefore, for at least the following reasons, Masuda does not anticipate claims 1, 21, 42, and 43.

Independent claims 48 and 50, as amended, recite "wherein said video signal is comprised of a first color signal, a second color signal, and a third color signal *with said first color signal including at least one key signal embedded therein*" and "wherein said output signal produces said image including said one or more special windows on said display *and said first and second color signals are used to display said at least one key signal to be displayed on said display*." Nothing found in Masuda teaches these aspects of the claimed invention. Masuda does not embed at least one key signal in a color signal in the video signal. Nor does Masuda teach using the color signal that includes the at least one key signal with another color signal to display the at least one key signal on the display. Therefore, for at least the following reasons, Masuda does not anticipate claims 48 and 50.

"Claims in dependent form shall be construed to incorporate by reference all of the limitations of the claim incorporated by reference into the dependent claim."

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37 CFR 1.75. Claims 2-4 and 44 depend from independent claim 1 and therefore include all of the limitations in claim 1, claims 22-24, 41, and 45 depend from independent claim 21 and therefore include all of the limitations in claim 21, claim 46 depends from independent claim 42 and therefore includes all of the limitations in claim 42, claim 47 depends from independent claim 43 and therefore includes all of the limitations in claim 43, claim 49 depends from independent claim 48 and therefore includes all of the limitations in claim 48, and claim 51 depends from independent claim 50 and therefore includes all of the limitations in claim 50. For at least the reason discussed above, Masuda does not anticipate independent claims 1, 21, 42, 43, 48, and 50. Accordingly, dependent claims 2-4, 22-24, 44-47, 49, and 51 are also not anticipated by Masuda.

103 Rejection

The Manual of Patent Examining Procedure states the following in Section 2142:

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

Applicant respectfully submits Masuda does not render Applicant's claimed invention obvious, since Masuda does not meet any of the three criteria listed above. The discussion below, however, will focus on the third criterion.

Amended independent claims 1 and 21 recite "special window information in a video signal comprised of a first color signal, a second color signal, and a third color signal *with said first color signal including said special window information*, wherein said video signal characterizes said image to be generated on said display *and said*

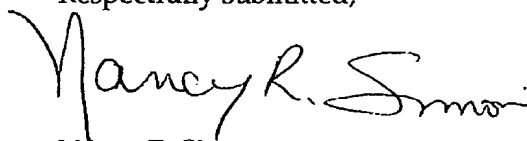
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first and second color signals are used to display said special window information on said display." Nothing found in Masuda teaches or suggests these aspects of the claimed invention. Masuda does not embed special window information in one color signal in the video signal. Nor does Masuda teach using the color signal that includes the special window information and another color signal to display the special window information on the display. Therefore, for at least the following reasons, Masuda does not anticipate independent claims 1 and 21.

When an independent claim is not rendered obvious by prior art, then any claim depending from the independent claim is not obvious. In re Fine, 5 USPQ2d 1596 (Fed. Cir. 1988) (see also M.P.E.P. § 2143.03). Claims 5-12 depend from independent claim 1 and claims 25-32 and 41 depend from independent claim 21. As discussed earlier, Masuda does not teach or suggest all of the claim limitations in claims 1 and 21. Therefore, Applicant respectfully submits claims 5-12, 25-32, and 41 are also not rendered obvious by Masuda.

In light of the discussion above, Applicant believes that all claims currently remaining in the application are allowable and respectfully requests allowance of such claims.

Respectfully submitted,



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